

REMARKS

This Amendment is accompanied by a Request for Continued Examination pursuant to 37 C.F.R. § 1.114, and the requisite large entity fee of \$810.00 pursuant to 37 C.F.R. § 1.17(e).

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Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 1, 10, 11 and 12 as being anticipated under 35 U.S.C. § 102(e) by Klarfeld et al. (U.S. Pub. No. 2003/0067554). In order for an application to be rejected on the basis of anticipation, each essential element of the claimed invention must appear in a single prior art reference. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). The absence of any one claimed element from such reference negates anticipation. *Id.*

Even if one assumes that the Klarfeld rating system is comparable to the priority levels of the present invention, Klarfeld does not anticipate the present invention. Specifically, Klarfeld does not disclose the application of one or more rules to each priority level in order to identify stored data that may be overwritten – the ‘rules’ cited by the Examiner pertain to the assignment of a rating to each portion of data. (See Klarfeld, ¶ 0168.)

When old data must be deleted to make room for new data, Klarfeld simply deletes the lowest rated data first, and then proceeds to higher rated data if additional space is needed. (See Klarfeld, ¶ 0169.) Klarfeld does not disclose any rules for dealing with different data sharing the same rating, or for bypassing data of a lower rating to delete data of a higher rating.

The present invention, on the other hand, provides rules governing each priority level. These rules determine, within each level, the data to be deleted in order to make room for new data. The present invention does so by examining the data at each priority level, and comparing the data with the level-specific rules to determine if the data should be deleted. Thus, the present invention ‘protects’ data that is not yet ready for deletion, regardless of that data’s priority level. It is possible under the present invention to skip over data at a lower priority level (i.e., to not delete the data if it does not satisfy the deletion rules of that lower priority level) and to delete data of a higher priority level (if that data satisfies the deletion rules for that higher priority level). This functionality is not disclosed, or anticipated, by Klarfeld. Moreover, base claims 1 and 10, as amended herein, include a retention rule at each priority level, which is not disclosed in Klarfeld. As such, the anticipation of these claims, and those which depend therefrom, based on Klarfeld is traversed.

Rejections Under 35 U.S.C. § 103

In order to find obviousness based upon a single prior art reference, there should be some showing of a suggestion or motivation to modify the teachings of that reference to arrive at the claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000).

For combinations of the prior art, there must be some motivation, suggestion or teaching of the desirability of making that specific combination. *Id.*; see *Alco Standard Corp. v. Tennessee Valley Auth.*, 808 F.2d 1490, 1498, 1 U.S.P.Q.2d 1337, 1343 (Fed. Cir. 1986); *Creative Pioneer Products Corp. v. K-mart Corp.*, 5 U.S.P.Q.2d 1841, 1844 (S.D. Tex. 1986); *KSR Int’l. v. Teleflex Inc.*, --- U.S. ---, 127 S.Ct. 1727, 1741 (2007).

The Examiner has rejected all of the remaining claims as being obvious over Klarfeld, either in view of Hayashi (US Patent No. 6,434,323) or Kimura (US Patent No. 7,096,237), or both. However, as discussed above, Klarfeld does not disclose any rules for dealing with different data sharing the same rating, or for bypassing data of a lower rating to delete data of a higher rating. The Examiner does not cite any language in
5 Klarfeld that would motivate, suggest or teach this process to a person of ordinary skill in the art.

Furthermore, neither Hayashi nor Kimura, either alone or in combination with Klarfeld, or with one another, motivate, suggest or teach the claimed process to a person
10 of ordinary skill in the art. As such, those references, either alone or in connection with Klarfeld or each other, do not render obvious the claims of the present invention.

Klarfeld and Hayashi (Claims 2-3, 5-9, 13, 15):

The Examiner has rejected claims 2, 3, 5 through 9, 13 and 15 as being unpatentable over Klarfeld, as applied to claims 1 and 10 through 12, and further in view
15 of Hayashi. However, Hayashi does not disclose, motivate, suggest or teach separate categories of data subject to deletion, or different retention rules for separate categories.

Instead, as demonstrated in Fig. 8 of Hayashi, such deletion is applied to the entire data, subject to the predefined conditions. (See col. 10, lines 21-28.). This is essentially a 'flat' data hierarchy, with no vertical categories or levels of data subject to deletion, nor
20 any 'step up' process to traverse the different categories or levels.

Fig. 8 further demonstrates that, unlike the present invention, all data deletion is apparently based upon the same set of erasure conditions. (See col. 10, lines 21-28.) Specifically, Fig. 8 places the record erasure condition (A02) outside the erasure loop

(A03-104). Repetition of the erasure loop therefore does not include any revision or re-evaluation of the record erasure condition. This is distinguishable from, and does not render obvious, the present invention, wherein each category or level may have its own data deletion rules.

5 Furthermore, the only deletion rule expressly disclosed by Hayashi is one based upon age. (See col. 10, lines 24-28.) In other words, Hayashi only discloses the deletion of the oldest data first, followed by successively younger data, as necessary. This is distinguishable from, and does not render obvious, the different level-specific rules disclosed and claimed herein, and does not motivate, suggest or teach those rules.

10 Even if the Examiner were to characterize the age of the data as a form of priority level, such characterization still results in a single-element data hierarchy, and neither Hayashi nor Klarfeld disclose any process or mechanism for dealing with different data of the same age level, or for 'protecting' data at any particular age level.

 As such, neither Klarfeld nor Hayashi alone or together disclose, motivate,
15 suggest or teach separate categories of data subject to deletion (the 'step up' process), or different retention rules for separate categories, the combination of these references cannot provide the necessary motivation, suggestion or teaching of either of these aspects of the present invention either. *See In re Kotzab*, 217 F.3d at 1370; *Alco Standard Corp.*, 808 F.2d at 1498. Accordingly, these claims should be allowed.

20 Klarfeld and Kimura (Claim 16):

 The Examiner has rejected claims 16 as being unpatentable over Klarfeld and Kimura. However, Kimura does not disclose, motivate, suggest or teach any means for organizing data into categories for the purposes of deleting said data according to

predefined rules, or means for traversing any different categories of deletion (the 'step up' process). In fact, Kimura is directed toward the recording and reproduction of audiovisual signals onto media, without any emphasis upon the reuse or recycling of such media once their capacities are reached.

5 Since neither Klarfeld nor Kimura disclose, motivate, suggest or teach different retention rules for separate categories, nor separate categories of data subject to deletion (the 'step up' process), the combination of these references cannot provide the necessary motivation, suggestion or teaching of these aspects of the present invention either. *See In re Kotzab*, 217 F.3d at 1370; *Alco Standard Corp.*, 808 F.2d at 1498. Accordingly, this
1.0 claim should be permitted.

Klarfeld, Hayashi and Kimura (Claim 18):

The Examiner has rejected claim 18 on the basis of Klarfeld, Hayashi and Kimura. However, as discussed above, neither Klarfeld, Hayashi nor Kimura, alone or in combination with one another, disclose, motivate, suggest or teach different retention
15 rules for separate categories, or separate categories of data subject to deletion (the 'step up' process). As such, these references do not render this claim as obvious.

Conclusion

Claims 3, 11 and 13 have been cancelled by this amendment, and new claims 19-24 have been added. Claims 4 and 14 were previously cancelled, bringing the total number of
20 pending claims to 19, and the total number of independent claims to 4. The fees for 3 independent claims have been previously paid, so an additional claims fee of \$220 is submitted herewith representing the large entity fee for a single additional independent claim.


This Amendment is also accompanied by a Request for Continued Examination pursuant to 37 C.F.R. § 1.114, and the requisite large entity fee of \$810.00 pursuant to 37 C.F.R. § 1.17(e).

Should any additional fees be required, the office is authorized to charge any such fees, or credit any overpayments, to deposit account 502429.

In view of the above, it is submitted that all of the claims are in condition for allowance. Allowance of the claims at an early date is solicited.

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Respectfully Submitted,

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